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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,486	07/20/2001	Fred N. Desai	8642	2573

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,486

Applicant(s)

DESAI ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1772

RESPONSE TO AMENDMENT

1. Claims 1-20 are pending in the application, claims 11-20 are withdrawn from consideration.

REJECTIONS REPEATED

2. The 35 U.S.C. §103 rejection of claims 1, 4 and 6 as over Nakahata (US Patent No. 5,873,868) in view of Curro et al. (US Patent No. 6,452,063) is repeated for reasons previously made of record in paper #13, mailed December 12, 2003, pages 3-4, paragraph #7.

3. The 35 U.S.C. §103 rejection of claims 7-10 as over Nakahata in view of Shimalla (US Patent No. 4,588,630) is repeated for reasons previously made of record in paper #13, pages 4-6, paragraph #8.

4. The 35 U.S.C. §103 rejection of claims 1-4 and 6 as over Nakahata in view of Shimalla and further in view of Curro is repeated for reasons previously made of record in paper #13, pages 6-7, paragraph #9.

5. The 35 U.S.C. §103 rejection of claim 5 as over Nakahata in view of Shimalla and further in view of Curro is repeated for reasons previously made of record in paper #13, pages 7-8, paragraph #10.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments in the response filed March 12, 2004 regarding the 35 U.S.C. §103 rejection over Nakahata in view of Curro of record have been carefully considered but are deemed unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Nakahata fails to teach the limitation of an open area greater than 15% and that the Examiner can not rely on the drawings in view of *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed Cir. 2000).

According to MPEP 2125, the drawings and pictures can anticipate claims if they clearly show the structure which is claimed. However, the picture must show all the claimed structural features and how they are put together. The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. In the instant case figure 4 in Nakahata clearly shows that the web has an open area greater than 15%.

Applicant also argues that Nakahata fails to teach or suggest a nonwoven web capable of at least 70% extension at a loading of 10 g/cm. Specifically, Applicant argues that the limitation "at a loading of 10 g/cm"

Art Unit: 1772

Claim 1 recites “a nonwoven web ... being capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. Therefore, since Nakahata discloses that the topsheet has an elastic extensibility of from about 10% to about 500% in the cross machine direction by a tensile force (*claim 8 and col. 10, lines 17-53 and col. 13, lines 7-20*), it is deemed to have the “ability to” have at least 70% extension in the cross machine direction at a loading of 10 g/cm, which reads on Applicant’s limitation. Furthermore, Applicant has not provided any evidence that Nakahata is not capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm.

Applicant argues that Curro fails to teach or suggest a nonwoven web comprising a plurality of apertures or a nonwoven web being capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm. Curro was not relied upon to disclose these features. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant argues that there is no suggestion or motivation to combine the references. Specifically, that Curro teaches away from the Offices’ proposed combination of Curro and Nakahata because Curro teaches a three-dimensional web and Nakahata discloses a two dimensional web. First, Nakahata’s web is three-dimensional because it has a length, width and thickness. Furthermore, there is no disclosure in Curro teaching that the aspect ratio will not work in other absorbent article tops. Therefore, Curro does not explicitly teach away from the combination with Nakahata.

Art Unit: 1772

Applicant argues that it is well settled that the Office cannot pick and choose among individual elements of assorted prior art references to recreate the invention based on the hindsight of Applicant's application. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In the instant case, Nakahata and Curro are analogous because they both disclose disposable absorbent article such as diapers, feminine hygiene garments, wipes, etc. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an aspect ratio of less than 6 in Nakahata as taught by Curro in order to provide the benefit of retaining more open area when the web is extended. One of ordinary skill in the art would have been motivated to use the aspect ratios taught by Curro because of the benefit of retaining more open area when the web is extended (*Curro col. 11, lines 3-25*).

7. Applicant's arguments in the response filed March 12, 2004 regarding the 35 U.S.C. §103 rejection over Nakahata in view of Shimalla of record have been carefully considered but are deemed unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 1772

Applicant argues that Shimalla fails to teach or suggest a nonwoven web comprising a plurality of apertures or a nonwoven web being capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm. Shimalla was not relied upon to disclose these features. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant argues that Shimalla and Nakahata may not be combined because to do so would render Nakahata unsatisfactory for its intended purpose. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. Furthermore, the arguments of counsel cannot take the place of evidence in the record. "An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. See MPEP 2145. Applicant has merely asserted that the combination destroys the intended purpose of the reference article, Nakahata, without providing any evidence from which the examiner could reasonably conclude that the invention would be destroyed by the combination.

Applicant argues that Nakahata and Shimalla, individually or in combination, fail to teach or suggest Applicant's claim limitation that the nonwoven web is "capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm." As stated above, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Therefore, since Nakahata discloses that

Art Unit: 1772

the topsheet has an elastic extensibility of from about 10% to about 500% in the cross machine direction by a tensile force (*claim 8 and col. 10, lines 17-53 and col. 13, lines 7-20*), it is deemed to have the "ability to" have at least 70% extension in the cross machine direction at a loading of 10 g/cm, which reads on Applicant's limitation. Furthermore, Applicant has not provided any evidence that Nakahata is not capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm.

Applicant argues that Nakahata and Shimalla fails to teach the limitation of an open area greater than 15%. As stated above, according to MPEP 2125, the drawings and pictures can anticipate claims if they clearly show the structure which is claimed. However, the picture must show all the claimed structural features and how they are put together. The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. In the instant case figure 4 in Nakahata clearly shows that the web has an open area greater than 15%.

8. Applicant's arguments in the response filed March 12, 2004 regarding the 35 U.S.C. §103 rejection over Nakahata in view of Shimalla and further in view of Curro of record have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the supposed deficiencies of the Nakahata, Shimalla and Curro references have already been addressed above.

Art Unit: 1772

9. Applicant's arguments in the response filed March 12, 2004 regarding the 35 U.S.C. §103 rejection over Nakahata in view of Curro and further in view of Benson of record have been carefully considered but are deemed unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Benson fails to teach or suggest a nonwoven web comprising a plurality of apertures or a nonwoven web being capable of at least 70% extension in the cross machine direction at a loading of 10 g/cm or a hole aspect ratio less than 6. Benson was not relied upon to disclose these features. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant's arguments regarding the combination Nakahata and Curro references have already been addressed above.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1772

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

5/25/04


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/26/04